

**REMARKS**

Claims 2, 6, 8, and 12 are canceled without prejudice, and therefore claims 1, 3 to 5, 7, and 9 to 11 are pending.

In view of this response, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

With respect to page two (2) of the Final Office Action, claims 6 and 12 were rejected under 35 U.S.C. § 112, first paragraph, as to the written description requirement. Specifically, the Final Office Action states that the feature in which “for a detection of cornering, no energy recuperation is performed,” as provided for in the context of claims 6 and 12, “is narrower than the original disclosure.” (Office Action, p. 2). Claims 6 and 12 have been canceled herein without prejudice, thereby rendering moot the present rejections as to those claims. The features of claims 6 and 12 have been included in claims 1 and 7, respectively.

In support of the features of claims 1 and 7, as presented, the Specification specifically states that “[i]n order to ensure the necessary vehicle stability, increasing braking power at the rear axle for the purpose of regaining energy makes sense only in braking procedures during straight-ahead driving.” (Specification, p. 8, lines 2-5). The Specification further states that “[i]n order not to endanger driving stability unnecessarily, the energy recovery is to be used predominantly during braking procedures during straight-ahead driving.” (Specification, p. 17, lines 11 to 14).

Therefore, it is respectfully submitted that it would be abundantly plain to a person having ordinary skill in the relevant art that the Applicants had possession of the claimed subject matter, and therefore that the written description requirement is satisfied as to the rejected claims.

*As further regards the written description requirement, the Office bears the initial burden of presenting “evidence or reasons why persons skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims” -- and not merely a list of terms that the Office does not understand. (See M.P.E.P. § 2163.04 (citing In re Wertheim 541 F.2d 257, 262, 265, 191 U.S.P.Q. 90, 96, 98 (C.C.P.A. 1976))) (emphasis added). In particular, the Manual of Patent Examining Procedure specifically provides that if the Office rejects a claim based on the lack of a written description, the examiner should “identify the claim limitation not described” and also provide “reasons why*

**persons skilled in the art would not recognize the description of this limitation in the disclosure of the application.**" (See *id.*).

It is respectfully submitted that the Office Action's arguments and assertions simply do not explain or identify why the rejected claims are not supported by the written description of the present application (and its specification) — which it plainly is, as explained herein.

In this regard, the Final Office Action does not even explain why a person skilled in the art would not recognize the features of claims 1 and 7, as presented (including as a grammatical matter). The present application makes this plain to any person having ordinary skill in the art (or any person for that matter).

As stated by the Board in *Ex parte Harvey*, 3 U.S.P.Q. 2d 1626, 1627 (Bd. Pat. App. Int. 1986) (emphasis added, citations omitted):

**Compliance with the written description requirement of Section 112 only requires that appellant's application contain sufficient disclosure, *expressly or inherently*, to make it clear to persons skilled in the art that appellant possessed the subject matter claimed. The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession of the claimed subject matter, rather than the presence or absence of literal support in the specification for the claimed language.**

Likewise, as stated by the Board in *Ex parte Sorenson*, 3 U.S.P.Q. 2d 1462, 1463 (Bd. Pat. App. Int. 1987) (emphasis added):

**[W]e are mindful that appellant's specification need not describe the claimed invention in *ipsis verbis* to comply with the written description requirement. The test is whether the originally filed specification disclosure reasonably conveys to a person having ordinary skill that applicant had possession of the subject matter later claimed. . . . Moreover, the Examiner has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in appellant's specification disclosure a description of the invention defined by the claims.**

In particular, the *Sorenson* Board, noting that the examiner only essentially stated that the claim expressions at issue did not "appear in the original disclosure" and that the claim expressions were therefore "not adequately supported by the few specific compounds in the specification," found that the examiner had not met his initial burden of "presenting evidence

why a person having ordinary skill in the art would not recognize in appellant's specification a description of the invention defined by the claims" — and that the "only reasoning presented" that the Board could discern was an "example of *ipse dixit* reasoning, resting on a bare assertion by the Examiner."

It is therefore respectfully submitted that the present application does satisfy the written description requirement of 35 U.S.C. § 112, first paragraph. Accordingly, it is respectfully requested that the "written description" rejection of the claims be withdrawn.

With respect to page two (2) of the Final Office Action, claims 1 to 12 were rejected under 35 U.S.C. § 102(b) as anticipated by JP 10-329681. Claims 2, 6, 8, and 12 have been canceled herein without prejudice, so as to render moot the present rejections as to those claims.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the prior Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (See *Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Final Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

Claim 1, as presented, includes the features in which the suitable measure further includes a redistribution of the retarding force of at least one wheel brake to other vehicle brakes of the vehicle, and in which for the redistribution of the retarding force to

energy-absorbing components, a displacement of the braking force distribution from the wheel brakes of a non-driven axle to the wheel brakes of a driven axle is performed, and further in which *for a detection of cornering, no energy recuperation is performed*.

It is respectfully submitted that any review of the Japanese reference makes plain that it does not identically disclose (or even suggest) these features, as provided for in the context of claim 1. The Japanese reference merely refers to altering the relative levels of hydraulic braking force and regenerative braking force in order to prevent brake squeal. The Japanese reference does not even indicate taking into account a detection of cornering, but only takes into account the presence of brake squeal, as provided for in the context of the claimed subject matter. Thus, nowhere does the Japanese reference disclose (or even suggest) the feature in which for a detection of cornering, no energy recuperation is performed, as provided for in the context of claim 1, as presented.

Accordingly, it is respectfully submitted that claim 1, as presented, is allowable for at least the reasons explained above. Claims 3 to 5 depend from claim 1, and are therefore allowable for at least the same reasons.

Claim 7, as presented, includes features similar to those of claim 1, as presented, and is therefore allowable for at least the same reasons as claim 1. Claims 9 to 11 depend from claim 7, and are therefore allowable for at least the same reasons.

Accordingly, it is respectfully submitted that claims 1, 3 to 5, 7, and 9 to 11 are allowable.

Withdrawal of the rejections of these claims is therefore respectfully requested.

**Conclusion**

It is therefore respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.

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